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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,531	04/15/2004	Hisashi Shinkai	228161	8241
23460	7590	07/19/2006	EXAMINER MAIER, LEIGH C	
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780			ART UNIT 1623	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/825,531	Applicant(s) SHINKAI ET AL.	
	Examiner Leigh C. Maier	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution, as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. 09/367,299.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-15, in the reply filed on May 17, 2006 is acknowledged. The traversal is on the ground that there would be no burden in searching the inventions together. This is not found persuasive because the searches are not coextensive. As noted in the restriction requirement, compounds embraced by the recited structural formula have known alternative utilities. In view of the extremely broad scope covered by the structural formula, it would indeed be a burden for searching all the enormous number of compounds embraced by this formula along with every possible utility for said compounds.

Upon reconsideration of the interrelatedness of the type of compounds set forth in the election of species requirement, this requirement is withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by the references set forth below. Because of the number of art compounds embraced by the instant claims, the examiner relies on the STN abstracts for the references disclosing these compounds.

US 4,740,438: See table in col 3.

STN Document No. 125:346011 (1996)

STN Document No. 113:31865 (1990)

Claims 1-4, 6-9 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by the references set forth below. Because of the number of art compounds embraced by the instant claims, the examiner relies on the STN abstracts for the references disclosing these compounds.

US 5,919,807: See Example C.

US 5,362,620: See table 1 at col 13.

US 4,337,357: See table at col 8.

US 3,920,444: See compound 147.

US 3,856,840: See formulas VII and VIII.

US 3,260,695: See col 1.

US 3,072,707: See examples.

STN Document No. 128:187834 (1998)

STN Document No. 128:69934 (1998)

STN Document No. 127:154564 (1997)

STN Document No. 126:205418 (1997)

STN Document No. 125:315234 (1996)

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STN Document No. 125:12380 (1996)

STN Document No. 123:56727 (1995)

STN Document No. 121:300556 (1994)

STN Document No. 119:271068 (1993)

STN Document No. 119:49289 (1993)

STN Document No. 114:14843 (1991)

STN Document No. 111:134067 (1989)

STN Document No. 106:213964 (1987)

STN Document No. 102:6270 (1985)

STN Document No. 101:72364 (1984)

STN Document No. 98:53154 (1983)

STN Document No. 93:46693 (1980)

STN Document No. 92:182320 (1980)

STN Document No. 92:76429 (1980)

STN Document No. 86:43636 (1977)

STN Document No. 81:152199 (1974)

STN Document No. 81:34416 (1974)

STN Document No. 73:65588 (1970)

STN Document No. 70:37376 (1969)

STN Document No. 67:64283 (1967)

STN Document No. 62:73989 (1965)

STN Document No. 62:3057 (1965)

STN Document No. 59:48311 (1963)

STN Document No. 57:76819 (1962)

STN Document No. 52:66145 (1958)

STN Document No. 31:10413 (1937)

STN Document No. 30:28955 (1936)

STN Document No. 30:28954 (1936)

Claims 1, 6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by the references set forth below. Because of the number of art compounds embraced by the instant claims, the examiner relies on the STN abstracts for the references disclosing these compounds.

US 4,157,444: See col 5-6.

US 4,038,300: See examples.

US 3,228,950: See example 10

US 2,596,755: See col 2.

STN Document No. 129:230631 (1998)

STN Document No. 127:171083 (1997)

STN Document No. 120:270251 (1994)

STN Document No. 120:217654 (1994)

STN Document No. 119:270811 (1993)

STN Document No. 89:59393 (1978)

STN Document No. 77:152102 (1972)

STN Document No. 71:38898 (1969)

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STN Document No. 67:90529 (1967)

STN Document No. 64:11913 (1966)

STN Document No. 62:22523 (1965)

STN Document No. 56:13208 (1962)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-9 and 11-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,753,346. Although the conflicting claims are not identical, they are not patentably distinct from each other because the species in the claims of '346 anticipate the instant claims.

Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,426,365. Although the conflicting claims are not identical, they are not patentably distinct from each other because the species in the claims of '365 anticipate the instant claims.

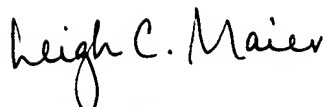
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Examiner's hours, phone & fax numbers

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh Maier whose telephone number is (571) 272-0656. The examiner can normally be reached on Tuesday, Thursday, and Friday 7:00 to 3:30 (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Anna Jiang (571) 272-0627, may be contacted. The fax number for Group 1600, Art Unit 1623 is (571) 273-8300.

Visit the U.S. PTO's site on the World Wide Web at <http://www.uspto.gov>. This site contains lots of valuable information including the latest PTO fees, downloadable forms, basic search capabilities and much more. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov> Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



Leigh C. Maier
Primary Examiner
July 14, 2006